

REMARKS

Status of Case

Applicant submits that, as is documented repeatedly throughout this Response, this case has failed to advance in a timely and cost-appropriate manner because of repeated failures to address Applicant's reasoned and lengthy responses to each and every of the Examiner's rejections.

More specifically, this case has failed to advance in a timely and cost-appropriate manner because of:

- Repeated failures to address justifiable and justified assertions of priority for the claims by Applicant, assertions which remain unaddressed despite *repeated* written and verbal requests for clarification by Applicant to the Examiner;
- Repeated failures to address the *specific statements* made by Applicant in support of Applicant's positions, and/or in response to Examiner's rejections;
- Repeated repetitions *essentially verbatim* of Examiner's old arguments, despite the failure of these repetitions to address the lengthy and reasoned statements made by Applicants in an attempt to advance prosecution and limit costs

Applicant submits that these failures have resulted in both undue delays in prosecution and excessive and unnecessary costs to Applicant, and further submits that it is *critical* that the Examiner now address these issues as raised throughout this Response, thereby obviating any need on the Applicant's part to appeal.

Status of Claims

Claims 25-28 have been added. These claims duplicate claims 7-10, with the exception that new claims 25-28 have been modified to depend from claim 24, rather than claim 5, as do claims 7-10. New claims 25-28 do not present new matter.

Claims 5, 7-10, 18-21, and 23-28 are now pending in the present application.

Status of Drawings

Figures 3-8 have been added. These figures are exact duplicates of figures 1-6 in the earliest filed application in the present case, U.S. Serial No. 07/376,380, filed July 6, 1989 (the "Priority Application"), modified to recite new figure numbers. In light of the continuity of the present application with the Priority Application, these newly added figures merely represent an explicit incorporation of that which was already present in the present application. Therefore, these newly added figures do not present new matter.

Figures 1-2 have been altered to the extent that the numbering in these figures has been modified so as not to conflict with the numbers recited in newly added figures 3-8. These changes in numbering do not present new matter. These changes are noted both in the accompanying annotated sheet of drawings, and as described below:

Figure 1. The number of sheets designator "1/1" has been deleted. The remainder of this paragraph refers to the labels used to designate the different components of the apparatus of the invention. Thus, "1" has been replaced with "101." "2" has been replaced with "102." "3" has been replaced with "103." "8" has been replaced with "108." "9" has been replaced with "109." "10" has been replaced with "110." "11" has been replaced with "111." "12" has been replaced with "112." "13" has been replaced with "113." "14" has been replaced with "114." Finally, "100" has been replaced with "1000."

Figure 2. The remainder of this paragraph refers to the labels used to designate the different components of the apparatus of the invention. Thus, “15” has been replaced with “115.” “16” has been replaced with “116.” “17” has been replaced with “117.” “18” has been replaced with “118.” “20” has been replaced with “120.” “21” has been replaced with “121.” “22” has been replaced with “122.” Finally, “200” has been replaced with “2000.”

Status of the Text of the Specification

The text of the specification has been modified to add the figure legends for newly added figures 3-8, and to change the numbers in the text citing to figures 1-2 to match the changes made to the numbering in these two figures. The text of the specification has also been modified to add the portion of the Priority Application that refers to newly added figures 3-8. In light of the continuity of the present application with the Priority Application, these additions merely represent an explicit incorporation of that which was already present in the present application. Therefore, none of these changes presents new matter.

PRIORITY

The Determination Of Priority For The Pending Claims Is Critical In Determining Whether U.S. Patent No. 4,911,339 to Cushing May Be Applied As A Reference Against The Pending Claims, And Must Now Be Resolved Without Further Delay Or Cost.

Applicant notes that a substantial portion of this Response is directed to a discussion of the Applicant’s longstanding inability to divine the Examiner’s intentions with regard to the priority of the pending claims to the earliest filed application in the present case, U.S. Serial No. 07/376,380, filed July 6, 1989 (the “Priority Application”). Applicant notes that this determination of priority is critical in determining whether U.S. Patent No. 4,911,339 to Cushing

(“Cushing”) may be appropriately cited against the claims, as the Examiner has repeatedly done. As Applicant will discuss in detail below, Applicant has been unable to determine from the written and verbal statements made by the Examiner over approximately the last year of prosecution 1) which claims have been accorded priority to the Priority Application, and which have not been accorded priority to this Priority Application; and, 2) to the extent that the Examiner has actually denied priority, on what grounds this denial has been made.

As Applicant discusses below, in the present Response, Applicant has assumed, as per the Examiner’s statements summarized in ¶¶ 6-7 of the attached paper entitled “Summary of the Examiner Interview of June 22, 2005,” that the Examiner *has* intended to accord priority to claims 5 and 8 as they were presented in the Response of December 19, 2003, and *has also* intended to accord priority to claim 24 presented in the Response of April 14, 2005.

Applicant notes that Applicant is forced to make these presumptions in light of the repeated failure to obtain any indication from the Examiner of his intentions in this regard. Applicant also submits to the Examiner that this situation has produced inappropriate delays in prosecution, as well as grossly enlarged prosecution costs, and asks that the Examiner carefully examine the statements made by Applicant and appropriately respond to these statements so that these matters may now be resolved without further delay, cost, or the necessity of appeal by the Applicant.

The Examiner’s Continued Omission Of The Priority Status Of Claims 5, 8, and 24, Both In His Office Actions And In Direct Telephonic Communication, Has Led To Inappropriate Delays And Costs In Prosecution, And Has Made It Impossible For The Applicant To Adequately Address The Rejections Made By The Examiner, And, Based On The Examiner’s Own Remarks, It Must Be Concluded That The Examiner Intends To Grant Priority To These Claims.

Applicant notes that during the course of prosecution the Examiner has failed to indicate to Applicant the priority status of claims 5, 8, and 24, both in his Office Actions and in the direct telephonic communication Applicant had with the Examiner on June 22, 2005. Applicant notes that this failure to indicate the priority status of these claims has continued despite *direct* queries to the Examiner regarding the priority status of these claims, and that it is critical that the priority of these claims be established, in order that the Applicant may appropriately respond to the Examiner's rejections.

Specifically, the Examiner has repeatedly not responded to direct statements regarding the priority of claims 5 and 8, which were first presented to the Examiner in Applicant's Response of December 19, 2003. This Response presented these claims as follows:

5. A misting apparatus for cooling a local area in the vicinity of a person by evaporative cooling, comprising:
 - a pressurizable container for supplying water;
 - means for pressurizing the container;
 - a water conduit having a proximal and distal end, the proximal end connected to the pressurizable container;
 - a spray nozzle secured to the distal end of the water conduit and in fluid communication with said water conduit, said spray nozzle delivering an evaporative cooling mist of water in the vicinity of a person for cooling the person when pressurized water is supplied to said spray nozzle; and
 - a restrictive valve having a closed position and an open position, said valve connected to said water conduit for controlling flow of water to said spray nozzle, whereby pressurization of said pressurizable container forces an uninterrupted spray of water from said pressurizable container out through said spray nozzle on said conduit when said restrictive valve is in said open position.

8. The misting apparatus of claim 5, wherein said container further comprises means for sealing said inlet for filling the container.

In the subsequent Office Action of January 9, 2004, although both these claims were before the Examiner for determination of priority, the Examiner indicated that “[c]laims 7, 9, 10, 18-21 and 23 have not been granted the benefit of the earlier filing date” *without indicating* the priority

status of pending claims 5 and 8. See Office Action of January 9, 2004, page 3. In fact the Examiner repeated this omission in the “Response to Arguments” on page 6 of the same Office Action, when he stated that “[c]laims 7, 9, 10, 18-21 and 23 have not been granted the benefit of applicant’s earlier filing date because applications 07/927,231; 07/698,356; 07/376,380 do not sufficiently disclose the claimed invention to comply with the requirements of the first paragraph of 35 U.S.C. 112.”

In Applicant’s subsequent Response of April 9, 2004, on page 4, the Applicant called the Examiner’s attention to this omission regarding the priority of claims 5 and 8 in the following statement:

The Applicant understands that since the Patent Office has failed to include claims 5 and 8 among the list of claims that have not been granted the benefit of the earlier filing date (claims 7, 9, 10, 18-21 and 23), claims 5 and 8 have been granted such benefit. Furthermore, the Applicant is unaware of the basis for the determination that the related, earlier filed applications fails to sufficiently disclosed the claimed invention under 35 U.S.C. §112, first paragraph. In spite of this, the Applicant believes this statement to be incorrect. The following demonstrates that the earlier filed applications do indeed support the current claimed invention and the should be granted the earliest filing date, July 6, 1989.

Emphasis added. In the resulting Office Action of June 15, 2004, however, the Examiner: 1) did not acknowledge or respond to the statement by Applicant cited above; 2) repeated the priority rejection of claims 7, 9, 10, 18-21 and 23 while *again omitting any reference* to claims 5 and 8 (see Office Action of June 15, 2004, page 2); and, 3) duplicated this same omission in the “Response to Arguments” section of the Office Action (see Office Action of June 15, 2004, page 7), a section where it would reasonably be expected that the Examiner would have responded to the priority statement made by the Applicant as provided above.

In the next Response provided by Applicant, that of April 14, 2005, the Applicant *yet again* called this omission to the Examiner’s attention:

Applicant has claimed priority for the pending claims of the present application to the July 6, 1989, filing date of the earliest filed application, namely, U.S. Serial No. 07/376,380 (the "Priority Application"). From the Examiner's response on page 7 of the Office Action of June 15, 2004 (the "Office Action"), *it again appears that the Examiner does not dispute this priority claim as it applies to currently pending independent Claim 5, and Claim 8 which depends therefrom, since neither of these claims are recited in the Examiner's discussion on page 7 of the Office Action.* On this basis Applicant assumes that U.S. Patent No. 4,911,339 ("Cushing") has been removed as a prior art reference against Claims 5 and 8. However, in the event that this is not the Examiner's intent, Applicant has amended independent claim 5 to overcome Cushing on independent grounds (see below). Applicant has also reproduced claim 5 with clarifying amendments as claim 24, in order to preserve the right to the subject matter of this claim in the event that Cushing in fact does not apply to this claim.

Response of April 14, 2005, pages 6-7 (emphasis added). However, despite this second indication to the Examiner that Applicant was unable to determine the status of these claims, in the most recent Office Action of April 27, 2005, the Examiner has once again denied priority to claims 7, 9, 10, 18-21 and 23 while *again completely omitting any reference to the priority status of claims 5 and 8.*

In addition to this third exemplar of omission of the status of claims 5 and 8 in the most recent Office Action, *this Office Action also fails to indicate the priority status of new claim 24,* which, as the preceding quotation recites, was added specifically to preserve the right to the subject matter of claim 5 as presented in the Response of December 19, 2003.

Applicant notes that the four omissions referenced above were *not* resolved when Applicant telephoned the Examiner on June 22, 2005, to specifically discuss this matter. Instead, as the attached paper entitled "Summary of the Examiner Interview of June 22, 2005" states in ¶ 11, the Examiner declined to tell Applicant what the priority status of claims 5, 8, or 24 is, and instead suggested that the Applicant ask for clarification of this issue in this Response.

Applicant submits that such clarification would have been much more appropriately provided early on in this process, thereby avoiding the excessive delay and costs that the continued uncertainty about the priority of the claims in question has produced.

In the present Response, Applicant has assumed, as per the Examiner's statements summarized in ¶¶ 6-7 of the attached paper entitled "Summary of the Examiner Interview of June 22, 2005," that the Examiner *has* intended to accord priority to claims 5 and 8 as they were presented in the Response of December 19, 2003, and *has also* intended to accord priority to claim 24 presented in the Response of April 14, 2005. Applicant notes that Applicant is forced to make this presumption in light of the repeated failure to obtain any indication from the Examiner of his intentions in this regard, and that Applicant requires confirmation of the Examiner's intentions in this regard, thereby obviating any need on the Applicant's part to appeal.

The Examiner Has Also Continued To Fail To Provide Any Basis For The Denial Of Priority For Claims 7, 9, 10, 18-21, and 23, And Therefore The Denial Of Priority For These Claims Must Be Withdrawn, And These Claims Granted Priority.

The Examiner has indicated in ¶ 3 (pages 2-3) of the most recent Office Action of April 27, 2005, that, because "Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S. C. 120 and/or 121, ... Claims 7, 9, 10, 18-21 and 23 have not been granted the benefit of the earlier filing date." However, in making this statement the Examiner 1) nowhere addresses the specific arguments presented by Applicant in the Response filed two weeks earlier, i.e., on April 14, 2005, regarding support for these claims in the Priority Application, a failure that 2) is a continuation of the non-addressing of the similar arguments made by Applicant over a year earlier in the Response of April 9, 2004.

Specifically, 1) the Examiner has not addressed any of the specific statements made by the Applicant in the Response of April 14, 2005, supporting the priority of the claims at issue; therefore, on this basis, the Examiner's denial of priority must be withdrawn, and these claims granted priority to the Priority Application. Thus in Applicant's Response of April 14, 2005, on page 7, Applicant made the following extensive statement with regard to the disputed claims as presented before amendment:

With regard to the Examiner's rejection of priority of the remaining claims to the filing date of the Priority Application, the Examiner indicates that these claims have not been granted this priority because the Priority Application does not sufficiently disclose all the limitations of these claims. In this regard, Applicant notes that the specification of the Priority Application in fact does support the breadth of these pending claims, and requests that the Examiner grant priority for these claims to the filing date of the Priority Application.

Thus with regard to claims 7, 9, and 10: while the specification does not explicitly state that the apparatus of the present invention may be worn on the waist, as recited in claim 7, it clearly discloses that this apparatus may be worn on the body of the user (e.g., the shoulders; see the specification, column 3, line 57 to column 4, line 7), which would include the waist; the specification explicitly discusses the use of the manual pump of claim 9 (specification, column 1, lines 55-64); and, with regard to the use of water and ice recited in claim 10, while ice is not explicitly recited in the specification, it would be within the knowledge of one skilled in the art of evaporative cooling to use ice as well as water to obtain such a cooling effect.

With regard to claims 18-21 and 23, Applicant is unable to determine from the statements on page 7 of the Office Action what aspects of these claims the Examiner considers as not disclosed within the Priority Application. Therefore, Applicant respectfully requests clarification from the Examiner regarding the specific basis for denying a grant of priority to the filing date of the Priority Application for these claims, and continues to assert a claim of priority for these claims subject to the Examiner's response.

However, despite this lengthy response to the Examiner's concerns regarding priority, in the following Office Action of April 27, 2005, this response was not discussed except in ¶ 13 (page 9), "Response to Arguments," where the Examiner's entire response to all of Applicant's arguments was merely that "Applicant's arguments with respect to claims 5, 7-10, 18-21, 23 and

24 have been considered but are moot in view of the new ground(s) of rejection.” Applicant submits that, given that no new grounds for denial of priority were presented – nor in fact have any specific *old* grounds for denial of priority been given – on the basis of the Examiner’s cursory response, Applicant is wholly unable to address the Examiner’s contentions regarding priority.

Furthermore, Applicant also notes that, in the third paragraph of the block quotation reproduced above, Applicant *explicitly* requested guidance regarding the grounds for rejection of priority for claims 18-21 and 23, with such guidance also not provided in the Office Action of April 27, 2005. Again, Applicant submits to the Examiner that, in the absence of *specific* information as to what information is lacking from the Priority Application that is present in the claims, as well as *specific* information as to how Applicant’s recitations of support in the Priority Application for the limitations recited in the claims is inadequate, Applicant is wholly unable to respond to the Examiner’s statements regarding a denial of priority for the claims to the Priority Application.

In continuation of this statement, and as presented in point 2) above, this non-addressing of the arguments made by Applicant in fact dates well over a year, i.e., dates not simply to Applicant’s Response of April 14, 2005, but in fact to Applicant’s earlier Response of April 9, 2004. Specifically, in the Response of April 9, 2004, on page 5, Applicant stated that:

In an attempt to anticipate the basis for the denial of benefit of the earlier filing date for claim 7, 9, 10, 18-21 and 23, the Applicants point out particular passages in the earliest filed application, U.S. Serial No. 07/376,380 (the “Priority Application”), which support the present claimed invention. The Applicant refers to U.S. Pat. No. 5,535,951, which is a continuation of Ser. No. 698,356, which is a continuation of Ser. 376,380, when providing citations to the Priority Application. In multiple sections of the Priority Application, the Applicant describes the apparatus as a misting apparatus. In particular, the Priority Application describes the inventive misting apparatus as one that is “adapted to deliver a spray of fluid and **evaporatively cool a localized area.**” See Col. 4, ln. 29-30 (Emphasis added). Additionally, Claim 1 includes the following preamble, “A method for emitting an **atomized spray** of a fluid to a localized area **for evaporatively cooling the localized area around a person.**” (Emphasis added).

The inventive apparatus, and more specifically, the sprayer, is patentable over the prior art at the time because of this new and unobvious sprayer that can emit a mist, or a fine mist or atomized spray, that evaporatively cools a localized area. Henceforth, this fully supports the claimed invention according to pending claims 7, 9, 10, 18-21 and 23 and, therefore, benefit of the earlier filing date should be granted.

(emphases in original). Applicant notes, first, that this quoted statement was made in response to the Examiner's statement in the Office Action of January 9, 2004, that priority had not been granted because Applicant had failed to meet the requirements of 35 U.S.C. 102 and/or 121, and the Examiner's further statement that:

Applicant's arguments filed December 19, 2003, have been fully considered but they are not persuasive.

In response to applicant's swearing behind Cushing, Claims 7, 9, 10, 18-21 and 23 have not been granted the benefit of applicant's earlier filing date because applications 07/927,231; 07/698,356; 07/376,380 do not sufficiently disclose the claimed invention to comply with the requirements of the first paragraph of 35 U.S.C. 112.

See Office Action of January 9, 2004, page 6. Applicant notes, second, that in response to Applicant's argument, the next Office Action of June 15, 2004, essentially repeated the earlier statement made by the Examiner without any further indication of the basis for denial of priority:

Applicant's arguments filed April 9, 2004, have been fully considered but they are not persuasive.

In response to applicant's swearing behind Cushing, Claims 7, 9, 10, 18-21 and 23 have not been granted the benefit of applicant's earlier filing date because applications 07/927,231; 07/698,356; 07/376,380 do not sufficiently disclose the claimed invention to comply with the requirements of the first paragraph of 35 U.S.C. 112. Applicant's arguments are not commensurate in scope with claims 7, 9, 10, 18-21 and 23. Applications 07/927,231; 07/698,356; 07/376,380 do not sufficiently disclose all the limitations of claims 7, 9, 10, 18-21 and 23.

Thus in summary, although the Examiner has maintained an objection to claims 7, 9, 10, 18-21 and 23, the basis for this rejection remains unclear despite 1) specific statements made by

In re: Appln No. 09/358,280
Atty Docket: 6030-021 (formerly MISTY-52064)
Customer No. 29,335

Applicant in support of the subject matter of these claims, which 2) date back well over a year, and to which the Examiner still has not responded.

On the basis of the above, Applicant submits that the denial of priority for claims 7, 9, 10, 18-21, and 23 must be withdrawn, and these claims granted priority. Applicant also notes that any continued rejection of priority for these claims should address the specific arguments made by Applicant, thereby obviating any need on the Applicant's part to appeal.

New Claims 25-28 Essentially Duplicate Claims 7-10, And Must Therefore Be Accorded Priority For The Reasons Given Above For Claims 7-10.

As discussed previously, newly added claims 25-28 duplicate claims 7-10, with the exception that claims 25-28 have been modified to depend from claim 24, rather than claim 5, as do claims 7-10. Since these claims essentially duplicate claims 7-10, they must therefore be accorded priority for the reasons presented above with regard to claims 7-10.

DRAWINGS

Because Every Feature Of The Claimed Invention Is Shown Either In The Drawings Of The Present Application Or In The Drawings Of The Applications To Which The Present Application Claims Priority And Which Are Part Of The Same Continuous Application, The Examiner's Objection To The Drawings Is Inapposite, And Must Be Withdrawn.

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims, specifically "the 'restrictive valve directly coupled to the inlet of the pressurizable container' recited in claims 5 and 18; and the 'non-removable means for pressurizing the pressurizable container' recited in claim 24." Office Action of April 27, 2005, page 3.

In response, Applicant directs the Examiner's attention to U.S. Patent No. 5,535,951 (the "951" patent), the disclosure of which is part of the same continuous application as the present application, and which contains drawings explicitly showing those features that the Examiner refers to in the Office Action.

Specifically, as was provided in the amendment to the specification filed as part of the Response of December 19, 2003. the present application:

... is a continuation of Serial No. 09/042,827 filed March 17, 1998, which is a continuation of Serial No. 08/802,072 filed February 19, 1997, now Patent No. 5,775,590, which is a continuation of Serial No. 08/664,302 filed June 10, 1996, now Patent No. 5,620,140, which is a continuation of Serial No. 08/324,872 filed October 18, 1994, abandoned, which is a continuation-in-part of Serial No. 07/927,231 filed August 7, 1992, now Patent No. 5,535,951, which is a continuation of Serial No. 07/698,356 filed May 7, 1991, now abandoned, which is a continuation of Serial No. 07/376,380 filed July 6, 1989, now abandoned.

As the U.S. Supreme Court noted in *Godfrey v. Eames*, 68 U.S. (1 Wall) 317, 325-26, 17 L.Ed. 684 (1864), applications in a continuous unbroken chain of priority are considered *part of the same transaction constituting one continuous application*, with the consequence that the features disclosed in the claims of a present application may be contained in the drawings of that application or of *any of the applications that are part of the same transaction*. Therefore, on this basis in the instant case the features recited in the claims as presented may be disclosed either in the drawings of the present application, or in the drawings of any of the applications to which the current invention claims priority, including the drawings of the '951 patent.

Thus with regard to the Examiner's first assertion that the "restrictive valve directly coupled to the inlet of the pressurizable container" recited in claims 5 and 18 is not shown in the drawings, Applicant directs the Examiner to Figures 1, 4, and 5 of the '951 patent, which in fact show this direct coupling. Specifically referring to the specification of the '951 patent as it refers to Figure 1, for example, the specification states that Figure 1 shows "a fluid tank 12, [and] a flow valve 22 coupled to a fluid outlet 20 of the tank" (see, e.g., column 2, lines 54-55), where

what the specification designates “fluid outlet 20” in fact is used as a fluid inlet as well (“[I]t is desirable, according to one preferred embodiment of the invention, to utilize fluid outlet 20 and flow regulator valve both to control the flow of fluid out of tank 12 and introduction of fluid into tank 12.” ‘951 patent, column 3, lines 39-42). Therefore, Figure 1 of the ‘951 patent explicitly shows a restrictive/flow valve directly coupled to the inlet/outlet of the pressurizable container/tank. A review of the ‘951 patent shows that Figures 4 and 5 similarly depict this direct coupling.

With regard to the Examiner’s second assertion that the ‘non-removable means for pressurizing the pressurizable container recited in claim 24 is not shown in the drawings, Applicant directs the Examiner’s attention to Figure 1 of the ‘951 patent, which shows “a gas valve 16, such as a SCHRADE valve, for *introducing* a gas, under pressure, into the pressurizable gas chamber 14.” ‘951 patent, column 2, lines 62-64 (emphasis added). This statement and both Figures 1 and 5 clearly show valve 16 as an exemplar of the “non-removable means for pressurizing the pressurizable container” recited in the claims, with support for the function of this valve as a means of pressurization found in the statement at column 3, lines 20-24 of the specification that “[w]hen valve 22 is opened, the fluid is immediately exposed to the ambient pressure and the expansive forces of the gas within gas chamber 14 propel the fluid from fluid chamber 18 into fluid outlet 20 and out of [the] tank.”

Thus both of the features that the Examiner asserts are missing from the drawings are in fact explicitly disclosed in the drawings of the ‘951 patent which, because it forms part of the same continuous application as the present application, appropriately serves as a valid source for these disclosures. Thus for these reasons the Examiner’s objection to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the invention is inapposite, and must be withdrawn.

Although The Drawings Of All Earlier Applications To Which The Current Application Claims Priority Are Correctly Incorporated Into The Present Application Merely By The Claiming Of Priority To These Earlier Applications, In Order To Remove Any Possibility Of Confusion On The Part Of The Examiner As To These Drawings, In The Present Response Applicant Has Explicitly Incorporated These Drawings Into The Present Application.

As discussed above, applications in a continuous unbroken chain of priority are considered part of the same transaction constituting one continuous application, with the consequence that the features disclosed in the claims of a present application may be contained in the drawings of that application or of any of the applications that are part of the same transaction. Thus the drawings of earlier applications to which the current application claims priority – drawings such as those in the application resulting in the ‘951 patent – are incorporated into the present application merely by the claiming of priority to these applications in the present application.

Despite this rule, to eliminate any confusion on the Examiner’s part as to the content of this application, Applicant now presents the drawings of the Priority Application for *explicit* incorporation in the present application, that is, for the incorporation of Figs. 1-6 of the Priority Application as Figs. 3-8 in the present application. In addition, Applicant has also modified the specification to include the descriptions of these figures provided in both the figure legends and detailed description of the specification of the Priority Application; again, because this text is part of the same continuous application, its addition is merely to make explicit that which is already present. Thus the additional figures or text is not new matter.

WRITTEN DESCRIPTION

The Rejection Of Claims 5, 7-10, 18-21, 23, And 24 Under 35 U.S.C. § 112, First Paragraph, As Lacking Adequate Written Description In The Specification Is Inapposite, In That It Incorrectly Fails To Consider The Disclosure Of The ‘951 Patent, And Must Therefore Be Withdrawn.

The Examiner has rejected claims 5, 7-10, 18-21, 23, and 24 under 35 U.S.C. § 112, First Paragraph, as lacking adequate written description in the specification. As Applicant will show below, this rejection is inapposite because it is based on a failure to consider the disclosures of the prior applications to which the present application claims priority, specifically the disclosure of the ‘951 patent, which explicitly provides the features of the present invention disclosed in the claims that the Examiner asserts lack adequate written description.

Specifically, as was discussed above with regard to the Examiner’s objections to the drawings, as the U.S. Supreme Court noted in *Godfrey v. Eames*, 68 U.S. (1 Wall) 317, 325-26, 17 L.Ed. 684 (1864), applications in a continuous unbroken chain of priority are considered *part of the same transaction constituting one continuous application*, with the consequence that the features disclosed in the claims of a present application may be contained in that application or *any of the applications that are part of the same transaction*. Therefore, although the Examiner may assert that “[t]he disclosure, as originally filed, fails to disclose a restrictive valve directly coupled to the inlet of the pressurizable container” (Office Action of April 27, 2005, page 4) or that “[t]he specification, as originally filed, fails to disclose a non-removable means for pressurizing the pressurizable container” (Office Action of April 27, 2005, page 5), in fact both of these limitations are explicitly disclosed in the applications to which the present application claims priority, specifically in the specification of the application resulting in the ‘951 patent.

Thus with regard to the Examiner’s first assertion that claims 5 and 18, as well as claims 7-10, 19-21, and 23 which depend therefrom, lack adequate written description in the specification for the recitation of “a restrictive valve directly coupled to the inlet of the

pressurizable container,” Applicant directs the Examiner’s attention to the specification of the ‘951 patent as it refers to Figure 1, where this limitation is clearly recited. Specifically, this section of the ‘951 patent states that Figure 1 shows “a fluid tank 12, [and] a flow valve 22 coupled to a fluid outlet 20 of the tank” (see, e.g., column 2, lines 54-55), where what the specification designates “fluid outlet 20” in fact is used as a fluid inlet as well (“[I]t is desirable, according to one preferred embodiment of the invention, to utilize fluid outlet 20 and flow regulator valve both to control the flow of fluid out of tank 12 and introduction of fluid into tank 12.” ‘951 patent, column 3, lines 39-42). Therefore, the specification of the ‘951 patent explicitly describes a restrictive/flow valve directly coupled to the inlet/outlet of the pressurizable container/tank, the Examiner’s rejection of claims 5, 7-10, 18-21, and 23 is inapposite, and the rejection of these claims must be withdrawn.

With regard to the Examiner’s second assertion that claim 24 lacks adequate written description in the specification for the recitation of a ‘non-removable means for pressurizing the pressurizable container,’ Applicant directs the Examiner’s attention to Figure 1 of the ‘951 patent, which shows “a gas valve 16, such as a SCHRADE valve, for introducing a gas, under pressure, into the pressurizable gas chamber 14.” ‘951 patent, column 2, lines 62-64. This statement clearly shows valve 16 as an exemplar of the “non-removable means for pressurizing the pressurizable container” recited in the claims, with support for the function of this valve as a means of pressurization found in the statement at column 3, lines 20-24 of the specification that “[w]hen valve 22 is opened, the fluid is immediately exposed to the ambient pressure and the expansive forces of the gas within gas chamber 14 propel the fluid from fluid chamber 18 into fluid outlet 20 and out of [the] tank.” Therefore, the Examiner’s rejection of claim 24 as lacking adequate written description is also inapposite, and must be withdrawn.

Thus both of the phrases that the Examiner asserts are inadequately described in the specification are in fact explicitly disclosed in the body of the ‘951 patent which, because it forms part of the same continuous application as the present application, appropriately serves as a valid source for these disclosures. Thus for these reasons the Examiner’s rejection of claims 5,

7-10, 18-21, 23, and 24 under 35 U.S.C. § 112, First Paragraph, as lacking adequate written description in the specification is inapposite, and must be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

The Rejection Of The Claims Under 35 U.S.C. § 102(b) As Anticipated By U.S. Patent No. 2,853,212 To Anderson Or U.S. Patent No. 4,911,339 To Cushing Is Inapposite And Must Be Withdrawn Because Anderson Does Not Recite Every Element Of The Claims, And Because Cushing Has Been Removed As An Antedating Reference And Additionally Does Not Recite Every Element Of The Claims.

The Examiner has rejected the claims either as anticipated by U.S. Patent No. 2,853,212 to Anderson (“Anderson”) and/or U.S. Patent No. 4,911,339 to Cushing (“Cushing”). As Applicant will discuss below, these rejections are inapposite and must be withdrawn because, for Anderson, the reference does not teach every element of the invention and therefore does not serve as an anticipating reference under 35 U.S.C. § 102(b), and because, for Cushing, the reference both does not teach every element of the invention, and, in addition, has been removed as an antedating reference.

I. The Rejection Of Claims 5, 8, 9, 18-19, 21, 23, And 24 As Anticipated By Anderson Is Inapposite And Must Be Withdrawn Because Anderson Does Not Teach Every Element Of The Claims.

At the outset, Applicant notes that a rejection based on 35 U.S.C. § 102(b) is appropriate only when the reference cited as anticipatory in fact discloses each and every element of the claims. Thus as stated in the Manual of Patent Examining Procedure (“MPEP”), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

inherently described, in a single prior art reference.” MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

With regard to the Examiner’s rejection of claims 5, 8, 9, 18-19, 21, 23, and 24 as anticipated by Anderson, each and every element of these claims is not provided in Anderson, and the rejection is therefore inapposite and must be withdrawn, as Applicant will demonstrate below.

A. The Examiner’s Rejection Of Claims 5, 8, 9, 18-19, 21, 23, And 24 As Anticipated By Anderson Is Inapposite And Must Be Withdrawn Because A Restrictive Valve Is Not Inherent In Anderson, Despite The Examiner’s Assertion To The Contrary.

In rejecting claims 5, 8, 9, 18-19, 21, 23, and 24 as anticipated by Anderson, the Examiner has repeated the argument that the restrictive valve recited in these claims is inherent in Anderson, where, the Examiner argues, it is required “in order to build up the pressure in container 10.” Office Action of April 27, 2005, page 5. However, in fact there is no support for the inherency of a restrictive valve in Anderson, because there is no basis to conclude that this feature is *necessarily* a part of the apparatus disclosed in Anderson, a requirement that the Examiner must meet in a rejection based on inherency.

Specifically, as stated in MPEP § 2112, “[t]he fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Instead, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Id.* (citing *Ex parte Levy*, 17USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 199) (emphases in original). Thus

“[t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *Id.* (emphasis added).

In the instant case, although the Examiner argues that a restrictive valve is necessary for a build-up of pressure in the apparatus of Anderson, a review of this apparatus as shown in Figure 1 or 2 of Anderson shows that pressure will build up in tank 10 regardless of the presence of a restrictive valve anywhere along the length, at the end, or at the beginning of tube 34, for the simple reason that the amount of pressure introduced with each up/down cycle of removable pump unit 13 vastly exceeds the ability of this pressure to escape through the thin hose of tube 34 shown in this figure. Thus while it may arguably be desirable *post hoc* to have a restrictive valve along the length, or at the end or beginning of tube 34, nothing in Anderson makes such a restrictive valve *necessary* to the functioning of the apparatus shown as a compression sprayer.

Furthermore, this conclusion is supported by the explicit language of Anderson, which states that,

[t]o enable a pressure to be built up in the tank by reciprocation of the pump plunger and retained therein for discharging the spray solution through the tube 34 to a spray nozzle (not shown), I have devised a novel check valve to prevent back-flow of pressure from the tank to the pump.

Anderson, column 3, lines 39-43. Thus the sole concern in Anderson in discussing the build-up of pressure is the back-flow that the pump mechanism might allow; and in fact there is absolutely no discussion of any restrictive valve in tube 34 as a way of enabling pressure. This position is supported by another citation from Anderson, which again is completely silent as to the existence or relevance of a restrictive valve when it states that,

[t]o now operate the assembled pump unit to build up air pressure in the tank, the handle 32 is rotated until it is disposed between the hook members 41, whereupon the handle may be manipulated to reciprocate the plunger.

Anderson, column 4, lines 33-37.

Thus on the basis of the above discussion, it is clear that there is nothing in Anderson to suggest that, as the Examiner has asserted, a restrictive valve is *required* for the function of the apparatus described. Therefore: the Examiner has not met the burden required for a sustainable assertion of inherency as set forth in MPEP § 2112; Anderson consequently does not teach every element of claims 5, 8, 9, 18-19, 21, 23, and 24; the rejection of these claims as anticipated by Anderson is inapposite; and, this rejection must therefore be withdrawn.

B. The Examiner’s Rejection Of Claims 5, 8, 9, 18-19, 21, and 23 As Anticipated By Anderson Is Inapposite And Must Be Withdrawn Because, Even Assuming, *Arguendo*, That Anderson Actually Does Inherently Disclose A Restrictive Valve, Anderson Still Does Not Provide A Direct Coupling Of The Restrictive Valve To The Pressurizable Container.

As discussed above, the Examiner’s rejection of claims 5, 8, 9, 18-19, 21, 23, and 24 is inapposite because Anderson does not inherently provide a restrictive valve, which is an explicit limitation of the claims rejected by the Examiner as anticipated by Anderson. However, even assuming, *arguendo*, that a sustainable argument could be made for the inherency of such a valve in Anderson, this reference would still not anticipate a subset of the rejected claims, i.e., claims 5, 8, 9, 18-19, 21, and 23, because it does not provide another explicit limitation of these claims, i.e., that the restrictive valve be *directly coupled* to the inlet of the pressurizable container.

Specifically, even if Applicant assumes that there is an inherent disclosure in Anderson of a restrictive valve – a point which, as discussed above, Applicant vigorously disputes – there is absolutely no teaching in Anderson to suggest the particular placement of such a valve explicitly provided in rejected claims 5, 8, 9, 18-19, 21, and 23, i.e., *directly coupled* to the inlet of the

pressurizable container. Anderson does not discuss a restrictive valve, nor does it show any restrictive valve in any of the figures.

Applicant notes that it is unfortunate that this argument must be reiterated in light of its previous *explicit* recitation in Applicant's prior Response of April 15, 2005. Specifically, in that Response, Applicant explicitly described to the Examiner the failure of Anderson to teach the direct coupling of the restrictive valve to the inlet of the pressurizable container:

The Examiner has rejected claims 5, 8-9, 18-19, 21, and 23 under 35 U.S.C. § 102(b) as anticipated by Anderson, U.S. Patent No. 2,853,212 ("Anderson"). This rejection will be traversed for independent claims 5 and 18, and for the remaining claims which depend therefrom. This rejection will then be traversed for new independent claim 24, which, as discussed above, is a recapitulation of claim 5 with minor amendments.

With regard to independent claim 5, Applicant has amended this claim to specify that the restrictive valve of this apparatus is *directly coupled* to the inlet of the pressurizable container. This situation is unlike that in Anderson, which describes a spray nozzle for discharging the spray solution, where the spray nozzle is connected *through a tube* to the pump-containing apparatus. Anderson, column 3, lines 39-42. Clearly the spray nozzle is, as Anderson describes, "for discharging the spray solution," and therefore functions as a restrictive valve. Since this restrictive valve is not *directly coupled* to the pump-containing apparatus of Anderson, Anderson does not anticipate independent claim 5. Therefore, the rejection of claim 5 as anticipated by Anderson has been obviated, and should be withdrawn.

With regard to independent claim 18, Applicant has amended this claim to indicate that the means for controlling the emission of evaporative mist comprises a restrictive valve *directly coupled* to the inlet of the pressurizable container. Therefore, for the same reasons as cited above for independent claim 5, independent claim 18 is not anticipated by Anderson. Therefore, the rejection of claim 18 as anticipated by Anderson has been obviated, and should be withdrawn.

With regard to remaining claims 8-9, 19, 21, and 23, which depend from independent claims 5 or 18, in light of the failure of Anderson to anticipate independent claims 5 or 18, it is axiomatic that dependent claims 8-9, 19, 21, and 23 are similarly not anticipated by Anderson. Therefore, since none of these dependent claims are anticipated by Anderson, the rejection as it applies to these claims should be withdrawn

Response of April 14, 2005, pages 8-9 (emphases in original). Applicant notes that, despite this complete and lengthy previous discussion of the failure of Anderson to teach the direct coupling limitation of the claims, the Examiner appears to have repeated his earlier grounds for rejection over Anderson without considering these lengthy Arguments presented by the Applicant.

Therefore, it is pure *post hoc* impermissible reasoning to conclude that this explicit limitation of the claims is provided in Anderson. And, because every element of a claim must be disclosed in a reference before that reference can act to anticipate that claim under 35 U.S.C. § 102(b), this reference therefore does not anticipate claims 5, 8, 9, 18-19, 21, and 23, is inapposite, and must be withdrawn.

C. The Examiner's Rejection Of Claim 24 As Anticipated By Anderson Is Inapposite And Must Be Withdrawn Because, Even Assuming, *Arguendo*, That Anderson Actually Does Inherently Disclose A Restrictive Valve, Anderson Does Not Teach A Non-Removable Means For Pressurizing The Pressurizable Container.

As discussed above, the Examiner's rejection of claims 5, 8, 9, 18-19, 21, 23, and 24 is inapposite because Anderson does not inherently provide a restrictive valve, which is an explicit limitation of the claims rejected by the Examiner as anticipated by Anderson. However, even assuming, *arguendo*, that a sustainable argument could be made for the inherency of such a valve in Anderson, this reference would still not anticipate claim 24, because Anderson clearly teaches a removable pressurizing means, rather than the *non-removable* pressurizing means that is an explicit limitation of claim 24.

Specifically, as discussed previously, in the Response of April 14, 2005, Applicant presented new claim 24 to preserve the subject matter of claim 5 as it existed prior to its amendment to specify the direct coupling of the restrictive valve to the inlet of the pressurizable

container. New claim 24 additionally contains the limitation that the means for pressurizing the pressurizable container be *non-removable*. Specifically, claim 24 is directed to:

A misting apparatus for cooling a local area in the vicinity of a person by evaporative cooling, comprising:
a pressurizable container for supplying water, said container having an inlet for filling said pressurizable container;
a *non-removable* means for pressurizing the pressurizable container by introducing a gas to the pressurizable container;
a water conduit having a proximal and distal end, the proximal end connected to the pressurizable container;
a spray nozzle secured to the distal end of the water conduit and in fluid communication with said water conduit, said spray nozzle capable of delivering an evaporative cooling mist of water in the vicinity of a person for cooling the person when pressurized water is supplied to said spray nozzle; and
a restrictive valve having a closed position and an open position, said valve connected to said water conduit for controlling flow of water to said spray nozzle, whereby pressurization of said pressurizable container forces an uninterrupted spray of water from said pressurizable container out through said spray nozzle on said conduit when said restrictive valve is in said open position.

Emphasis added. Therefore, in order for the Examiner to validly find Anderson as anticipating the subject matter of this claim, the Examiner must show that Anderson teaches a *non-removable* means for pressurizing the pressurizable container.

In this regard, first, Anderson in fact *does not* teach such a non-removable pressurizing means, and instead explicitly and repeatedly teaches a *removable* pressurizing means, specifically the pump unit assembly 13 which, as Anderson states, “*may be removed* for access to the filling opening to replenish the supply of spray solution or liquid in the tank.” Anderson, column 1, lines 67-71 (emphasis added). The removable nature of pump unit assembly 13 is made even more plain in column 3, lines 67-75, which discusses a collar and coil spring for the pump unit assembly so that this assembly may be mounted and sealed “after each filling of the tank for which the pump unit or assembly *must be removed* for access to the filling opening of the tank. . . .” Emphasis added.

Second, Applicant submits that the *removable* nature of the pressurizing means disclosed in Anderson should already have been clear to the Examiner, given that the Applicant *explicitly* indicated this fact to the Examiner in Applicant's previous Response of April 14, 2005. Specifically, on page 9 of this response, in a paragraph *drawn specifically to the Examiner's rejection of the claims as anticipated by Anderson*, the Applicant noted:

With regard to new independent claim 24, this claim recites a *non-removable* means for pressurizing the pressurizable container. Since Anderson explicitly and repeatedly describes a *removable* pump unit (Anderson, column 1, lines 67-71), Anderson does not anticipate new independent claim 24. Therefore, this claim should not be rejected as anticipated by Anderson.

Emphases in original. Given the clarity of this statement, Applicant is at a loss to understand the Examiner's basis for rejecting claim 24 as anticipated by Anderson.

Third, it appears that at least part of the explanation for the rejection may derive from the fact that, despite this plain and explicit teaching in Anderson and in the previous Response of the *removable* nature of the pressurizing means in Anderson, the Examiner has based his rejection of claim 24 on essentially an *exact duplication* of his earlier rejection of claims which *do not contain* the limitation that the pressurizing means be non-removable. Thus Applicant directs the Examiner's attention to a comparison of numbered ¶ 7 of the present Office Action with numbered ¶ 6 of the Office Action of June 15, 2004. Comparison of the first two paragraphs in these sections shows that these paragraphs differ only in that the phrase "21 and 23" in the first paragraph of the earlier Office Action has been replaced with the phrase "21, 23 and 24 (as best understood)" in the first paragraph of the present Office Action, and the phrase "23," in the second paragraph of the earlier Office Action has been replaced with the phrase "23 and 24," in the second paragraph of the present Office Action. Specifically, the pertinent section of the Office Action of June 15, 2004, states:

Claims 5, 8, 9, 18, 19, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (2,853,212).

With respect to claims 5,8, 9 and 23, Anderson discloses an apparatus comprising: a pressurizable container 10; means 13 for pressurizing the container; a water conduit 34 (a first conduit – portion of conduit 34 inside container 10; a second conduit – portion of conduit 34 outside container 10); a spray nozzle (column 3, lines 42); a restrictive valve (inherent in order to build up the pressure in container 10); a means for sealing 16.

These two paragraphs are modified by the following superficial deletions (indicated by square brackets) and insertions (indicated by underlining) in the corresponding section of the present Office Action of April 27, 2005, which is directed to a set of claims modified from those to which the previous Office Action was drawn, including the *completely different* claim 24 (see above):

Claims 5, 8, 9, 18, 19, [21 and 23]21, 23 and 24 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (2,853,212).

With respect to claims 5,8, 9 and [23,]23 and 24, Anderson discloses an apparatus comprising: a pressurizable container 10; means 13 for pressurizing the container; a water conduit 34 (a first conduit – portion of conduit 34 inside container 10; a second conduit – portion of conduit 34 outside container 10); a spray nozzle (column 3, lines 42); a restrictive valve (inherent in order to build up the pressure in container 10); a means for sealing 16.

Although such superficial changes are certainly acceptable in certain circumstances, they are not appropriate here, where the mere repetition of the Examiner's earlier verbiage is in fact non-responsive for failing to discuss the amendments that Applicant has made to the claims, particularly claim 24. In this regard, Applicant notes that it is unhelpful to prosecution, as well as extremely costly to Applicant to present modifications to the claims that are then not addressed.

Applicant further notes that there is no explanation provided by the Examiner of the phrase “as best understood” as it applies to claim 24. Again, Applicant is unable to divine the Examiner’s understanding of the claims from such statements, resulting in heightened delays and costs in prosecution. Therefore, Applicant requests that the Examiner please explicitly indicate to Applicant the meaning of this phrase.

In summary, in light of the failure of the Examiner to present any evidence to suggest that Anderson teaches the non-removable pressurizing means of claim 24, and further in light of the Examiner’s mere repetition of his earlier verbiage without addressing this claim, it is clear that there has been no adequate showing that claim 24 has been anticipated by Anderson, and the rejection of this claim on this basis must therefore be withdrawn.

II. The Rejection Of Claims 5, 8, 18-19, 21, 23, And 24 As Anticipated By Cushing Is Inapposite And Must Be Withdrawn Because Cushing Is Not A Valid Antedating Reference And Additionally Does Not Recite Every Element Of The Claims.

A. The Examiner’s Rejection Of Claims 5, 8, 18-19, 21, 23, And 24 As Anticipated By Cushing Is Inapposite And Must Be Withdrawn Because Cushing Has Been Removed As An Antedating Reference.

As discussed previously, Applicant has repeatedly provided evidence to the Examiner that Cushing is not a valid an antedating reference of the claims of the present invention in light of the earlier priority date of the Priority Application to which the present application correctly claims priority.

Also as discussed previously, the Examiner has repeatedly failed to address these arguments. Also as discussed, from the Examiner's statements Applicant concludes that the Examiner *has* intended to accord priority to the claims to the Priority Application.

Therefore, it is clear that Cushing does not validly serve to anticipate the claims of the present invention; that the rejections on the basis of this reference are therefore inapposite; and, that these rejections must therefore be withdrawn.

B. The Examiner's Rejection Of Claims 5, 8, 18-19, 21, And 23 As Anticipated By Cushing Is Inapposite And Must Be Withdrawn Because, In Addition To The Fact That Cushing Is Not A Valid Antedating Reference, Cushing Does Not Provide A Direct Coupling Of The Restrictive Valve To The Pressurizable Container.

As discussed above, the rejections under 35 U.S.C. § 102(b) of the claims as anticipated by Cushing must be withdrawn because Cushing is not a valid antedating reference. However, in addition to this fact, with regard to claims 5, 8, 18-19, 21, and 23, Cushing does not teach every element of the claims, and therefore *cannot* anticipate them, even assuming, *arguendo*, that it could be applied – which Applicant emphatically notes cannot be the case.

Specifically, like Anderson, Cushing does *not* teach the direct coupling of a restrictive valve to the inlet of the pressurizable container. Also like Anderson, this fact should not be a surprise to the Examiner, given that it was discussed at great length in the prior Response of April 14, 2005:

The Examiner has rejected claims 5, 8, 18-19, 21, and 23 under 35 U.S.C. § 102(b) as anticipated by Cushing, U.S. Patent No. 4,911,339 (“Cushing”). This rejection will be traversed for independent claims 5 and 18, and for the remaining claims which depend therefrom. This rejection will then be traversed for new

independent claim 24, which, as discussed above, is a recapitulation of claim 5 with minor amendments.

With regard to independent claim 5, this claim is not anticipated by Cushing in light of its amendment to recite a restrictive valve *directly coupled* to the pressurizable container. Specifically, Cushing explicitly discloses the use of a hand-operated valve to release water to a bicycle rider, where this valve is necessarily at the end of the tube that connects the handlebar-mounted valve to the water bottle reservoir located above the bicycle's gear system. Since Cushing does not disclose a valve attached to the water bottle reservoir itself, Cushing clearly does not anticipate claim 5 as currently amended. Therefore, the rejection of this claim as anticipated by Cushing has been obviated, and should be withdrawn.

With regard to independent claim 18, Applicant has amended this claim to indicate that the means for controlling the emission of evaporative mist comprises a restrictive valve *directly coupled* to the inlet of the pressurizable container. Therefore, for the same reasons as cited above for independent claim 5, independent claim 18 is not anticipated by Cushing. Therefore, the rejection of claim 18 as anticipated by Cushing has been obviated, and should be withdrawn.

With regard to remaining claims 8, 19, 21, and 23, which depend from independent claims 5 or 18, in light of the failure of Cushing to anticipate independent claims 5 or 18, it is axiomatic that dependent claims 8, 19, 21, and 23 are similarly not anticipated by Cushing. Therefore, since none of these dependent claims are anticipated by Cushing, the rejection as it applies to these claims should be withdrawn.

Response of April 14, 2005, pages 9-10. Although these paragraphs are self-explanatory, and provide sufficient evidence in-and-of themselves, further evidence that Cushing does *not* provide the direct coupling limitation of claims 5, 8, 18-19, 21, and 23 is provided in, e.g., the statements in Cushing that the valve is situated on the handle bars of the bicycle, *away from* the water container in the water-bottle holder:

"The invention, in its preferred embodiment includes a cylindrical water pump having a hand operated valve and sprayer disposed upon the *handle bars* of the bicycle, within easy reach of the rider." Cushing, column 2, lines 4-7 (emphasis added).

“Preferably, the hand operated valve and nozzle assembly is removably secured to the *handle bars* of the bicycle, within easy reach of the rider.” Cushing, column 2, lines 16-19 (emphasis added).

“The hand operated valve and nozzle assembly 44 is adapted to be secured to the handle bars 22 of an ordinary bicycle 14 by a clamping means 24.” Cushing, column 3, lines 60-62 (emphasis added).

Thus it is clear that, even assuming, *arguendo*, the applicability of Cushing, Cushing does not teach every element of claims 5, 8, 18-19, 21, and 23, and their rejection as anticipated by Cushing must therefore be withdrawn.

C. The Examiner’s Rejection Of Claim 24 As Anticipated By Cushing Is Inapposite And Must Be Withdrawn Because, In Addition To The Fact That Cushing Is Not A Valid Antedating Reference, Cushing Does Not Teach A Non-Removable Means For Pressurizing The Pressurizable Container.

As discussed above, the rejection under 35 U.S.C. § 102(b) of the claims as anticipated by Cushing must be withdrawn because Cushing is not a valid antedating reference. However, in addition to this fact, with regard to claim 24, Cushing does not teach every element of this claim, and therefore *cannot* anticipate it, even assuming, *arguendo*, that it could be applied – which Applicant emphatically notes cannot be the case.

Specifically, Cushing does not teach a non-removable means for pressurizing the pressurizable container, which is an explicit limitation of claim 24, and instead discloses a pump that is *removable*. Thus the pleated bellows portion of the apparatus of Cushing is disclosed as removable, in for example, the statement “both the lid 36 and the pleated bellows 40 are screw threaded to opposite ends 38, 41, respectively, of the container 16, so as to be *removably* secured

thereto.” Cushing, column 3, lines 38-41 (emphasis added). Similar statements may be found in Cushing at column 4, lines 33-35 and again at lines 51-54.

As Applicant discussed previously, a rejection based on 35 U.S.C. § 102(b) is appropriate only when the reference cited as anticipatory in fact discloses each and every element of the claims. Cushing clearly does not disclose the *non-removable* pressuring means of claim 24; therefore, on this basis alone (and in addition to the inappropriateness of Cushing as a reference) Cushing does not anticipate claim 24, and the rejection on this basis must be withdrawn.

New Claims 25-28 Essentially Duplicate Claims 7-10, And Must Therefore Must Not Be Rejected Under 35 U.S.C. § 102(b) As Anticipated By U.S. Patent No. 2,853,212 To Anderson Or U.S. Patent No. 4,911,339 to Cushing For The Reasons Given Above For Claims 7-10.

As discussed previously, newly added claims 25-28 duplicate claims 7-10, with the exception that claims 25-28 have been modified to depend from claim 24, rather than claim 5, as do claims 7-10. Since these claims essentially duplicate claims 7-10, they must not be rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,853,212 to Anderson or U.S. Patent No. 4,911,339 to Cushing for the reasons given above for claims 7-10.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

The Rejection Of Claims 5, 8, 9, 18-19, 21, 23, and 24 Under 35 U.S.C. § 103(a) As Obvious Over U.S. Patent No. 2,853,212 To Anderson In View Of U.S. Patent No. 842,689 To Norman Must Be Withdrawn Because The Combination Of References Does Not Recite Every Element Of The Claims.

The Examiner has rejected claims 5, 8, 18-19, 21, 23, and 24 under 35 U.S.C. § 103(a) as obvious over Anderson in view of U.S. Patent No. 842,689 (“Norman”). However, as discussed above, Anderson does not teach every element of these claims, nor is this deficiency remedied by Norman.

For example, and with regard to claims 5, 8, 18-19, 21, or 23, neither Anderson nor Norman teach the direct coupling limitation of these claims. This fact has been discussed at great length above with regard to Anderson, and arguments similar to these also apply to Norman.

And with regard to claim 24, neither reference teaches, for example, the non-removable pressurizing means of this claim. This fact has been discussed at great length above with regard to Anderson. With regard to Norman, see column 1, lines 36-40, which describe the removable attachment of the pump component of the apparatus to the tank via bolts; see also, bolts 8 of Figure 2, which are shown with winged heads specifically adapted to aid bolt removal and withdrawal of the pump component of the apparatus.

Therefore, the combination of Anderson and Norman does not render any of claims 5, 8, 18-19, 21, 23, and 24 obvious under 35 U.S.C. § 103(a), and the rejection must be withdrawn.

The Rejection Of Claim 10 Under 35 U.S.C. § 103(a) As Obvious Over Cushing In View Of U.S. Patent No. 4,960,419 To Rosenberg Must Be Withdrawn Because The Combination Of References Does Not Recite Every Element Of The Claims.

The Examiner has rejected claim 10 “as best understood” under 35 U.S.C. § 103(a) as obvious over Cushing in view of U.S. Patent No. 4,960,419 (“Rosenberg”). With regard to this rejection, Applicant notes that there is no explanation provided by the Examiner of the phrase “as best understood” as it applies to claim 10. Applicant is unable to divine the Examiner’s understanding of the claims from such statements, resulting in heightened delays and costs in

prosecution. Therefore, Applicant requests that the Examiner please explicitly indicate to Applicant the meaning of this phrase as it specifically applies to claim 10.

Despite the inability of the Applicant to discern the Examiner's understanding of claim 10 in light of the Examiner's use of the phrase "as best understood," and the concomitant inability of the Applicant to most accurately address the Examiner's rejection, Applicant submits that it is clear that, as already discussed, Cushing alone does not disclose every element of claim 10, and that this incomplete recitation of every element of claim 10 is not cured by the combination of Cushing with Rosenberg. On this basis, the rejection of claim 10 as obvious over Cushing in view of Rosenberg must be withdrawn.

The Rejection Of Claims 7 And 20 Under 35 U.S.C. § 103(a) As Obvious Over Cushing In View Of U.S. Patent No. 4,852,781 To Shurnick Must Be Withdrawn Because The Combination Of References Does Not Recite Every Element Of The Claims.

The Examiner has rejected claims 7 and 20 "as best understood" under 35 U.S.C. § 103(a) as obvious over Cushing in view of U.S. Patent No. 4,852,781 ("Shurnick"). With regard to this rejection, Applicant notes that there is no explanation provided by the Examiner of the phrase "as best understood" as it applies to claims 7 and 20. Applicant is unable to divine the Examiner's understanding of the claims from such statements, resulting in heightened delays and costs in prosecution. Therefore, Applicant requests that the Examiner please explicitly indicate to Applicant the meaning of this phrase as it specifically applies to claims 7 and 20.

Despite the inability of the Applicant to discern the Examiner's understanding of claims 7 and 20 in light of the Examiner's use of the phrase "as best understood," and the concomitant inability of the Applicant to most accurately address the Examiner's rejection, Applicant submits that it is clear that, as already discussed, Cushing alone does not disclose every element of claims 7 or 20, and that this incomplete recitation of every element of these claims is not cured by the

combination of Cushing and Shurnick. On this basis, the rejection of claims 7 and 20 as obvious over Cushing in view of Shurnick must be withdrawn.

The Rejection Of Claim 9 Under 35 U.S.C. § 103(a) As Obvious Over Cushing In View Of Anderson Must Be Withdrawn Because The Combination Of References Does Not Recite Every Element Of The Claims.

The Examiner has rejected claim 9 under 35 U.S.C. § 103(a) as obvious over Cushing in view of Anderson. With regard to this rejection, Applicant notes that there is no explanation provided by the Examiner of the phrase “as best understood” as it applies to claim 9. Applicant is unable to divine the Examiner’s understanding of the claims from such statements, resulting in heightened delays and costs in prosecution. Therefore, Applicant requests that the Examiner please explicitly indicate to Applicant the meaning of this phrase as it specifically applies to claim 9.

Despite the inability of the Applicant to discern the Examiner’s understanding of claim 9 in light of the Examiner’s use of the phrase “as best understood,” and the concomitant inability of the Applicant to most accurately address the Examiner’s rejection, Applicant submits that it is clear that, as already discussed, Cushing alone does not disclose every element of claim 9, and that this incomplete recitation of every element of claim 9 is not cured by the combination of Cushing and Anderson. On this basis, the rejection of claim 9 as obvious over Cushing in view of Anderson must be withdrawn.

New Claims 25-28 Essentially Duplicate Claims 7-10, And Must Therefore Must Not Be Rejected Under 35 U.S.C. § 103(a) As Obvious For The Reasons Given Above For Claims 7-10.

As discussed previously, newly added claims 25-28 duplicate claims 7-10, with the exception that claims 25-28 have been modified to depend from claim 24, rather than claim 5, as do claims 7-10. Since these claims essentially duplicate claims 7-10, they must not be rejected under 35 U.S.C. § 103(a) as obvious under the various combinations of the references given above for the reasons given above for claims 7-10.

Applicant's Discussion Of The "Response To Arguments" Section Of The Office Action.

Applicant takes issue with the Examiner's statement in the "Response to Arguments" portion of the Office Action of April 27, 2005, that "Applicant's arguments with respect to claims 5, 7-10, 18-21, 23 and 24 have been considered but are moot in view of the new ground(s) of rejection." Office Action of April 27, 2005, page 9. As the preceding 44 pages of argument make clear, most of Applicant's previous arguments were in fact not moot, and the failure to address these arguments in the Office Action of April 27, 2005, has now necessitated the voluminous present Response.

Applicant has noted previously that the result of the issues noted above has been two-fold: lengthy delays in prosecution; and, excessive costs of prosecution. Therefore, as stated previously, Applicant requests that the Examiner fully and carefully consider the entire content of this Response, thereby obviating any need on the Applicant's part to appeal.

CONCLUSION

This response is being filed concurrently with an Amendment Transmittal and a paper entitled "Summary of the Examiner Interview of June 22, 2005." The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Rosenbaum & Associates, P.C. deposit account No. 18-2000.

In re: Appln No. 09/358,280
Atty Docket: 6030-021 (formerly MISTY-52064)
Customer No. 29,335

In light of the foregoing discussion, Applicant respectfully submits that all outstanding requirements have been met, and that claims 5, 7-10, 18-21, and 23-28 should be allowed.

Should the Examiner require any further information or wish to discuss an aspect of this Response, the Examiner is encouraged to telephone the undersigned at the telephone number set forth below.

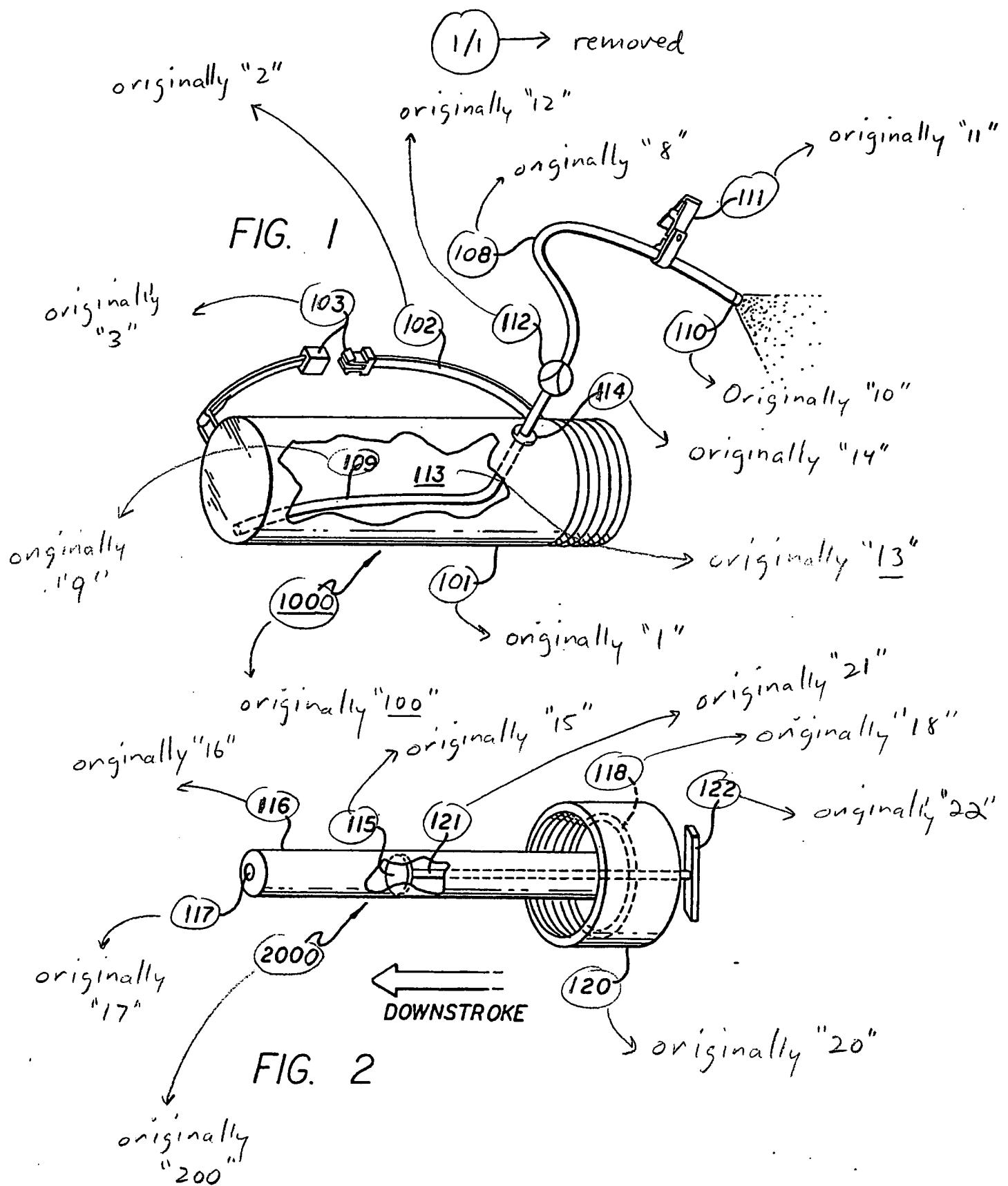
Respectfully submitted,



Andrew O. Scheinman
Reg. No. 50,730

August 2, 2005

ROSENBAUM & ASSOCIATES, P.C.
650 Dundee Road
Suite 380
Northbrook, IL 60062
Direct Tel. 847-770-6019
Tel. 847-770-6000
Fax. 847-770-6006
E-mail: ascheinman@biopatentlaw.com



Annotated Sheet